

JUN 20 2006

**PIONEER HI-BRED INTERNATIONAL, INC.  
CORPORATE INTELLECTUAL PROPERTY DEPARTMENT**

**FAX TRANSMISSION**

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7250 N.W. 62<sup>nd</sup> Avenue  
P.O. Box 552  
Johnston, Iowa 50131-0552

Phone: (515) 254-2823  
Fax: (515) 334-6883

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TO: Mail Stop Petition  
Commissioner for Patents

FROM: Steven Callistein

RE: Soybean Variety XB19U04  
Serial No. 10/768,489  
Case 1800

DATE: 6/20/2006 FAX NUMBER: (571) 273-8300

NUMBER OF PAGE(S) FOLLOWING THIS SHEET: 14

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**COMMENTS:**

1. Petition to Withdraw Holding of Abandonment-Notice of Allowance not Received – 2 pages
2. Statement Regarding PTO Documents Received – 1 page
3. Incomplete Notice of Allowance – 8 pages
4. Docket Records – 3 pages

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CENTRAL FAX CENTER

JUN 20 2006

Attorney Docket No. 1800

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Stephens et al. Date: June 20, 2006

Serial No.: 10/768,489 Group Art Unit: 1638

Filed: January 30, 2004 Examiner: Ibrahim, Medina Ahmed

For: Soybean Variety XB19U04

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PETITION TO WITHDRAW HOLDING OF ABANDONMENT –  
NOTICE OF ALLOWANCE NOT RECEIVED**

1. I hereby Petition to withdraw the holding of abandonment in this case, on the basis that the complete Notice of Allowance forming the basis of the abandonment was not received.

2. I hereby state:

- (a) The Notice of Allowance, as mailed on August 12, 2005, was received in part (the first two pages of the Notice of Allowance were missing and thus the issue fee could not be paid).
- (b) A call was placed to the Patent Office and the Applicants were told that a new Notice of Allowance would be sent.

3. I attach a copy of the Notice of Allowance papers that were initially received (the incomplete copy).

4. To date, a complete copy of said Notice of Allowance has not been received by our office. A statement from the person who would have handled the receipt of the new Notice of Allowance had it been received is attached hereto. Also attached hereto is a copy of our docketing records showing that the only

complete Office Action received from the Patent Office was the Office Action dated March 24, 2005 to which an Amendment was filed on June 15, 2005.

5. In consideration of these submissions, it is respectfully requested that the holding of abandonment be withdrawn and a new Notice of Allowance with a new three month reply date be issued.

No fees or extensions of time are believed to be due in connection with this Petition; however, in the event that extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR §1.136(a), and any fee required therefore is hereby authorized to be charged to Deposit Account No. 16-1852.

— Respectfully submitted,



Steven Callistein  
Attorney for Applicant(s)  
Registration No. 43,525

PIONEER HI-BRED INTERNATIONAL, INC.  
Corporate Intellectual Property  
7250 N.W. 62<sup>nd</sup> Avenue  
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JUN 20 2006

Attorney Docket No. 1800

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Stephens et al. Date: June 20, 2006

Serial No.: 10/768,489 Group Art Unit: 1638

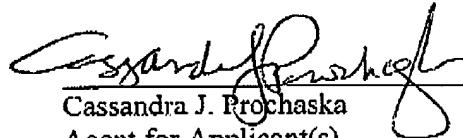
Filed: January 30, 2004 Examiner: Ibrahim, Medina Ahmed

For: Soybean Variety XB19U04

STATEMENT REGARDING PTO DOCUMENTS RECEIVED

I, Cassandra J. Prochaska, a licensed patent agent, do hereby state:

1. I received a copy of the incomplete Notice of Allowance mailed by the Patent Office on August 12, 2005.
2. I telephoned the Patent Office to inform them of the missing pages in said Notice of Allowance and was informed that a new Notice of Allowance would be mailed to replace the one dated August 12, 2005.
3. That to date I have not received said new Notice of Allowance.
4. I further state that I have reviewed the entire file located at Pioneer Hi-Bred International, Inc. and have reviewed the docket records at our office (a copy of which is attached hereto) and to date we have not received the new Notice of Allowance as indicated above.

  
\_\_\_\_\_  
Cassandra J. Prochaska  
Agent for Applicant(s)  
Registration No. 56,434



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
 P.O. Box 1450  
 Alexandria, Virginia 22314-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,489	01/30/2004	Paul Alan Stephens	1800	6475
29310	7590	08/12/2005	EXAMINER	
PIONEER HI-BRED INTERNATIONAL, INC.			IRRAHM, MEDINA AHMED	
7250 N.W. 62ND AVENUE			ART UNIT	PAPER NUMBER
P.O. BOX 552				1638
JOHNSTON, IA 50131-0552			DATE MAILED: 08/12/2005	

**Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)**  
 (application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 0 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 0 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571) 272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at (703) 305-8283.

<b>Notice of Allowability</b>	Application No.	Applicant(s)
	10/768,489	STEPHENS ET AL
	Examiner Medina A. Ibrahim	Art Unit 1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS. This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1.  This communication is responsive to the telephone interview of 08/04/05.
2.  The allowed claim(s) is/are 1-16.
3.  The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4.  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a)  All
  - b)  Some\* c)  None of the:
    1.  Certified copies of the priority documents have been received.
    2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3.  Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5.  A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6.  CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
  - (a)  including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
    - 1)  hereto or 2)  to Paper No./Mail Date \_\_\_\_\_.
  - (b)  including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.

Identifying Indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7.  DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1.  Notice of References Cited (PTO-892)
2.  Notice of Draftsperson's Patent Drawing Review (PTO-948)
3.  Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date \_\_\_\_\_
4.  Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5.  Notice of Informal Patent Application (PTO-152)
6.  Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_.
7.  Examiner's Amendment/Comment
8.  Examiner's Statement of Reasons for Allowance
9.  Other \_\_\_\_\_.

Application/Control Number: 10/768,489  
Art Unit: 1638

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### EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Steven Callistein on 08/04/05.

The application has been amended as follows:

In The Specification:

On page 49 of the specification (see the amendment of 6/15/05), the last two sentences, " U.S. Plant Variety Protection of Soybean Variety XB19U04 may be applied for. Unauthorized seed multiplication prohibited. " have been deleted.

In The Abstract:

The abstract on page 52 of the specification has been replaced with the following:

----According to the invention, there is provided a novel soybean variety, designated XB19U04. This invention thus relates to the seeds of soybean variety XB19U04, to the plants of soybean XB19U04, and to methods for producing a soybean plant by crossing soybean variety XB19U04 with another soybean plant, using XB19U04 as either the male or the female parent. This invention also relates to

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methods for introducing a transgene into soybean variety XB19U04 and plants produced by said methods. ---

In The Claims:

At claims 3-4, the first "part" has been replaced with ---or a part thereof---.

At claim 6, "plant tissue" in line 2 has been replaced with ---a plant part---.

At claim 7, "having all" in line 2 has been replaced with ---wherein the regenerated plant has all of -----.

At claim 8, ---progeny--- has been inserted before the last "soybean" in line 3.

Claim 9 (New). A method of producing a herbicide resistant soybean plant comprising introducing a transgene conferring herbicide resistance into the plant of claim 2.

Claim 10 (New). A herbicide resistant soybean plant produced by the method of claim 9.

Claim 11 (New). The soybean plant of claim 10, wherein the transgene confers resistance to a herbicide selected from the group consisting of glyphosate, sulfonylurea, imidazolinone, glufosinate, triazine, and benzonitrile.

Claim 12 (New). A method of producing an insect resistant soybean plant comprising introducing a transgene conferring insect resistance into the soybean plant of claim 2.

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Claim 13 (New). An insect resistant soybean plant produced by the method of claim 12.

Claim 14 (New). A method of producing a disease resistant soybean plant comprising introducing a transgene that confers disease resistance into the soybean plant of claim 2.

Claim 15 (New). A disease resistant soybean plant produced by the method of claim 14.

Claim 16 (New). The soybean plant of claim 13, wherein the transgene encodes a *Bacillus thuringiensis* polypeptide.

#### REASONS FOR ALLOWANCE

The following is an examiner's statement of reasons for allowance: Applicant has developed a soybean variety XB19U04 which is properly deposited under 37 CFR 1.801-1.809. Numerous morphological and physiological characteristics of soybean variety are taught in Tables 1 and 2 (pp. 14-15) of the specification. The closest prior art is the soybean cultivar 92B63 of Freestone (US 6,326,529). However, soybean cultivar XB19U04 differs from the prior art cultivar at least in that it has a relative maturity group 1 and subgroup 9, resistance to Race 3 cyst nematode and also differs in seed oil and protein contents (Table 2). The prior art does not teach or fairly suggest any soybean

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Art Unit: 1638

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cultivar that has the combination of all the traits as listed in Tables 1 and 2.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

#### Contact information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Medina A. Ibrahim whose telephone number is (571) 272-0797. The Examiner can normally be reached Monday -Thursday from 8:00AM to 5:30PM and every other Friday from 9:00AM to 5:00 PM. Before and after final responses should be directed to fax nos. (703) 872-9306 and (703) 872-9307, respectively.

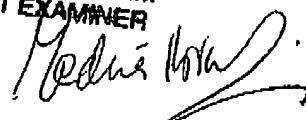
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dr. Amy Nelson, can be reached at (571) 272-0804.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

8/02/05  
Mai

MEDINA A. IBRAHIM  
PATENT EXAMINER



JUN 20 2006

**Examiner-Initiated Interview Summary**

Application No.	Applicant(s)	
10/768,489	STEPHENS ET AL	
Examiner	Art Unit	
Medina A. Ibrahim	1638	

**All Participants:**(1) Medina A. Ibrahim**Status of Application:** allowed

(3) \_\_\_\_\_

(2) Steven Callistein

(4) \_\_\_\_\_

**Date of Interview:** 4 August 2005**Time:** \_\_\_\_\_**Type of Interview:** Telephonic Video Conference Personal (Copy given to:  Applicant  Applicant's representative)**Exhibit Shown or Demonstrated:**  Yes  No

If Yes, provide a brief description:

**Part I.****Rejection(s) discussed:****Claims discussed:**

all

**Prior art documents discussed:****Part II.****SUBSTANCE OF INTERVIEW DESCRIBING THE GENERAL NATURE OF WHAT WAS DISCUSSED:**

See Continuation Sheet

**Part III.**

It is not necessary for applicant to provide a separate record of the substance of the interview, since the interview directly resulted in the allowance of the application. The examiner will provide a written summary of the substance of the interview in the Notice of Allowability.

It is not necessary for applicant to provide a separate record of the substance of the interview, since the interview did not result in resolution of all issues. A brief summary by the examiner appears in Part II above.

(Examiner/SPE Signature)

(Applicant/Applicant's Representative Signature – if appropriate)

Continuation Sheet (PTOL-413B)

Application No. 10/768,489

Continuation of Substance of Interview including description of the general nature of what was discussed: Applicants' representative authorized attached Examiner's amendment. Applicants' representative reassured that Applicants will satisfy all the deposit requirements of 37 C.F.R.1.801 - 1 .809, including the requirement "all restrictions upon availability to the public will be irrevocably removed upon granting of the patent".

**Country Application**

Thursday, June 15, 2006

Page: 1

Case Number: 1800	Country: US	SubCase:
Division: Soybean	United States of America	
Attorneys: SJC	CJP	
Title: Soybean Variety XB19U04		
Case Type: PRI	Application Status: Published	
Application Number: 10/768,489	Filing Date: 30-Jan-2004	
Publication Number: 0172707	Publication Date: 02-Sep-2004	
Patent Number:	Issue Date:	
Parent/PCT Number: 10/768,489	Parent/PCT Date : 30-Jan-2004	
Parent Issue Number:	Parent Issue Date :	
Tax Schedule: LE	Expiration Date:	
Confirmation #: 6475	Patent Term Adjustment: 0	
Agent:	Deposit Number: PTA-6442	

Associate Info:	Abandoned Date:
-----------------	-----------------

**Family Reference:****Inventors:**

Stephens, Paul A.  
Fuessley, Blair C.

**Actions Due****Thursday, June 15, 2006 Page: 1****Case Number:** 1800**SubCase:****Country:** US      **United States of America****Case Type:** PRI**Status :** Published**Filing Date:** 30-Jan-2004**Action Type:** US-Office Action**Base Date:** 24-Mar-2005**Application #:** 10/768,489**Response sent date:** 15-Jun-2005

Action(s) Due	Due Date	Indicator	Taken
1 Month to Due Date	24-May-2005	Reminder	15-Jun-2005
3 Month Due Date	24-Jun-2005	Final	15-Jun-2005
1st Extension	24-Jul-2005	Due Date	15-Jun-2005
2nd Extension	24-Aug-2005	Due Date	15-Jun-2005
2 Weeks to Final Date	08-Sep-2005	Due Date	15-Jun-2005
6 Month Final	24-Sep-2005	Final	15-Jun-2005

**Remarks:**

claims 1-8.

**User ID:** Kelly Parker**Date Created:** 30-Mar-2005**Last Update:** 21-Jun-2005

**Country Application**

Thursday, June 15, 2006

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**List Of Actions**

Action(s) Due	Due Date		Action Taken
US/Foreign Filing Reminder	29-Feb-2004	Final	30-Jan-2004
Information Disclosure Stmt	30-Apr-2004	Due Date	28-Apr-2004
Foreign Filing Reminder	30-Jul-2004	Reminder	30-Jan-2004
US/Foreign Fili Follow Up Date	30-Jul-2004	Due Date	30-Jan-2004
US/Foreign Filing Reminder	30-Jul-2004	Due Date	30-Jan-2004
US/Foreign Filing Reminder	30-Dec-2004	Due Date	30-Jun-2004
1 Month to Due Date	24-May-2005	Reminder	15-Jun-2005
3 Month Due Date	24-Jun-2005	Final	15-Jun-2005
1st Extension	24-Jul-2005	Due Date	15-Jun-2005
Application Status Check	30-Jul-2005	Due Date	20-Oct-2005
2nd Extension	24-Aug-2005	Due Date	15-Jun-2005
2 Weeks to Final Date	08-Sep-2005	Due Date	15-Jun-2005
6 Month Final	24-Sep-2005	Final	15-Jun-2005

**User ID:** Kelly Parker**Date Created:** 05-Feb-2004**Last Update:** 21-Jun-2005